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Supreme Court of the United States,

OCTOBER TERM, 1935.

No. 388

A. G. TRIPLETT, R. M. TRIPLETT, A. NELSON, C. M. TRIPLETT, JR., and THE BALTIMORE GAS-LIGHT COMPANY,

Petitioners,

vs.

PERCIVAL D. LOWELL, FRANCIS W. DUNMORE, and DUBILIER CONDENSER CORPORATION,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE FOURTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

SAMUEL E. DARBY, JR.,
Counsel for Petitioners.

COOK & MARKELL,
Attorneys for Petitioners.

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PETITION FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE FOURTH CIRCUIT.

TO THE HONORABLE, THE CHIEF JUSTICE AND ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioners respectfully pray for a writ of certiorari to the Circuit Court of Appeals for the Fourth Circuit, to review a judgment of that Court rendered June 3, 1935. A transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith in accordance with Rule 38 of the rules of this Court.

Summary and Short Statement of the Matter Involved.

This suit was instituted in the District Court of Maryland for alleged infringement of patents, including Dunmore patent No. 1,635,117 and Lowell and Dunmore patent No. 1,455,141.

These two patents were previously in litigation in a suit brought in the District of Delaware by the same plaintiffs against Radio Corporation of America. In the Delaware case the Court of Appeals for the Third Circuit, speaking through Judge Woolley, found claim 9 of patent No. 1,635,117 and claims 3 and 14 of patent No. 1,455,141 to be invalid on the grounds (1) that the claims covered mere unpatentable aggregations, and (2) that the claims defined no patentable invention over what was well known and in use in the prior art (50 Fed. (2) 305; 309). Petitions for rehearing were denied on July 6, 1932, and this Court denied writs of certiorari on October 25, 1932 (287 U. S. 648, 650).

On July 8, 1933—*eight months and thirteen days after the denial of certiorari*—plaintiffs filed disclaimers in the Patent Office with respect to certain claims of each of the patents, including the claims which had been held to be invalid (See Appendix A, pp. 20, 21). The disclaimers, however, did not purport to disclaim the invalid claims. On the contrary, the admitted intent and effect of the disclaimer was to import into the claims a limitation not theretofore included therein. In other words, the disclaimer filed with respect to both of the patents was of the type and character and in the form condemned by this Court in *Altoona Publix Theatres* vs. *American Tri-Ergon*, 294 U. S. 477.

Indeed, plaintiffs contended in the Courts below, and the Court of Appeals accepted the contention, that the claims should be treated as though no disclaimers had been filed. Thus, plaintiffs stated in their brief in the Court below—

> "No disclaimer was really required; it was filed purely as a matter of precaution to insure that the patent would be construed according to settled law. If it was filed too late or if it is otherwise objectionable the disclaimer is invalid and the patentee then is entitled to rest on his specification and claims as they stood in his original patent construed according to settled law."
>
> * * * * * * *
>
> "The disclaimers do no more than invoke and insure the rule of construction of their claims laid down by

> Westinghouse vs. Boyden supra; they do not cancel anything; in the language of the Court below (Vol. 1, p. 263) 'they seem to me not to disclaim at all'."

The Court of Appeals based its decision below on the assumption to that effect. It said (Vol. 1, p. 424; 77 Fed. (2) 556, 559),

> "We may assume, for the purposes of the pending case, that in effect no disclaimer has been filed as to the claims passed on in the Third Circuit * * *".

On August 17, 1933—*over nine months after the denial of certiorari*—plaintiffs filed the present suit charging infringement of the claims of the two patents that had previously been held to be invalid by the Court of Appeals for the Third Circuit, as well as of other claims in both patents which were not involved in that suit.

When the case was called to trial before the District Court, defendants presented a motion to dismiss the bill of complaint as to the first two patents on the authority of *Ensten* vs. *Simon Ascher & Co.*, 282 U. S. 455, on the ground that plaintiffs' delay of eight months and thirteen days in filing disclaimers with respect to the invalidated claims of the patents was "unreasonable" neglect or delay, and in consequence, the patents were wholly invalid. The District Court denied this motion.

Thereupon, defendants presented a motion to dismiss the bill of complaint as to the first two patents on the ground that no adequate disclaimer had been filed because of the admitted fact that the disclaimers did not purport to, or in fact, disclaim anything, but merely imported into the claims limitations not theretofore included in the claims. Indeed, the only way that the decision of the Court of Appeals for the Third Circuit (that the claims were invalid because of aggregation and want of invention) could have been properly met by plaintiffs would have been by an actual and complete disclaimer of the invalidated claims.

Though admitting that no disclaimer had been filed or was intended to have been filed to meet the invalidating decision

of the Third Circuit Court of Appeals, plaintiffs opposed this motion on the ground that there was nothing to compel them to file disclaimers and thereby avail themselves of the disclaimer statute; that the decision of the Circuit Court of Appeals for the Third Circuit invalidating some of the claims of the two patents was effective only in the Third Circuit, except as against the defendant in that case; and that plaintiffs by *not* disclaiming the invalid claims could sue on those claims and other claims of the patent at any time during its life in any Circuit other than the Third Circuit.

The District Court granted the second motion and dismissed the bill as to the two patents (Vol. I, p. 263).

The Court of Appeals for the Fourth Circuit reversed the District Court, sustained plaintiffs' contentions, and remanded the case to the District Court for a trial on the merits (77 Fed. (2) 556).

The patents relate to wireless signalling systems, and if this petition for a writ of certiorari is not granted, a lengthy trial, involving highly technical subject matter, covering the same ground previously covered by the District Court of Delaware and the Court of Appeals for the Third Circuit, will be necessitated.

The litigation also involved a third patent, the subject matter and disposition of which is not involved in the present petition.

The Questions Presented.

The questions presented for determination by this Court, in the event the present petition is granted, are:

1. Can a patentee sue, or maintain a suit in one Judicial Circuit on the claims of his patent that have previously been finally decreed to be invaid by a Court of competent jurisdiction and of last resort in another Judicial Circuit?

2. *Must* a patentee disclaim, within a reasonable time, the claims that have been held to be invalid by a Court of last

resort in one Circuit in order to thereafter sue, or maintain a suit for infringement of other claims of the patent in another Circuit. Stated another way; is it *compulsory* on or merely *optional* with a patentee to disclaim the claims which have been invalidated by a Court of last resort in one Circuit, before he can sue or maintain a suit for infringement of the patent in another Circuit?

3. Can a patentee, who has filed an inadequate and invalid disclaimer after a Court of last resort in one Circuit has declared one or more claims of the patent to be invalid, thereafter institute and/or maintain a suit on the patent in another circuit and treat the invalidated claims as though no disclaimer had been filed with respect thereto, on the theory that the patentee disagreed with the prior decree of invalidation, and was entitled to a determination *de novo* by the Court of another Circuit on the issue of the validity of the claims which had previously been finally adjudged to be invaid.

Reasons Relied on for Allowance of the Writ.

The discretionary power of this Court is invoked upon the following grounds:

1. Because the decision of the Court of Appeals for the Fourth Circuit in this case holding, in effect, that there was no compulsion upon the patentee to disclaim the claims previously adjudged to be invalid by the Court of Appeals for the Third Circuit, as a condition precedent to the commencement (more than nine months subsequent thereto) or maintenance of the present suit, is directly opposed to and in direct conflict with the decision of this Court in *Ensten* vs. *Simon Ascher & Co.*, 282 U. S. 455.

2. Because the decision of the Court of Appeals for the Fourth Circuit in this case, holding in effect that the in-

adequate and invalid disclaimer filed by the patentee more than eight months after the previous adjudication of invalidity by the Court of Appeals of another Circuit, can be ignored, and a trial on the merits had as though no disclaimer in fact had been filed, is directly opposed to and in direct conflict with the decision of this Court in *Altoona Publix Theatres* vs. *American Tri-Ergon*, 294 U. S. 477.

3. Because the rule established by the decision of the Court of Appeals for the Fourth Circuit in this case in construing the disclaimer sections of the statute (Sections 4917 and 4922 R. S.) as to the necessity for filing disclaimers, and the time within which they must be filed, is in direct conflict with the rule established by the Court of Appeals for the Second Circuit in *Hoe & Co.* vs. *Goss Printing Press Co.*, 31 Fed. (2) 565; *Better Packages Inc.* vs. *Nashua Package Sealing Co. et al.*, 6 Fed. Supp. 673, affirmed 74 Fed. (2) 682, certiorari denied, 55 S. Ct. 830; *Radio Condenser Co.* vs. *General Instrument Corp.*, 65 Fed. (2) 458.

4. Because the decision of the Circuit Court of Appeals for the Fourth Circuit in this case, to the effect that the present suit was properly brought or can be maintained, notwithstanding the prior adjudication of invalidity of some of the claims of the patents, and the failure to file a disclaimer of the invalid subject matter, is directly opposed to the express provisions of Section 4922 R. S.

5. Because the case involves important questions of patent law arising under the patent statutes which should be settled by this Court.

WHEREFORE your petitioners respectfully pray that a writ of certiorari be issued under the seal of this Court directed to the United States Circuit Court of Appeals for the Fourth Circuit, commanding the said Court to certify and send to

this Court on a day to be designated, a full and complete transcript of the record and all proceedings in the Circuit Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court; that the judgment of the Circuit Court of Appeals be reversed, and that petitioners be granted such other and further relief as may seem proper.

SAMUEL E. DARBY, JR.,
Counsel for Petitioners.

COOK & MARKELL,
Attorneys for Petitioners.

Dated: New York, N. Y., August 20, 1935.

BRIEF FOR PETITIONERS IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of the Courts Below.

The opinion of the District Court is reproduced in Vol. 1, p. 263. The opinion of the Court of Appeals is reported in 77 Fed. (2) 556 (Vol. 1, p. 417).

Jurisdiction.

The date of the judgment is June 3, 1935 (Vol. 1, p. 417). The statute under which jurisdiction is invoked is Section 240(a) of the Judicial Code (28 U. S. C. 347, as amended). Cases believed to sustain the jurisdiction are *DeForest Radio Co.* vs. *General Electric Co.*, 283 U. S. 664; *Carbice Corp. of America* vs. *American Patents Development Co., et al.*, 283 U. S. 27; *Simmons* vs. *Grier Bros.*, 258 U. S. 82; *Altoona Publix Theatres* vs. *American Tri-Ergon Corp.*, 294 U. S. 477.

Statement.

The facts, so far as this application is concerned, are sufficiently stated in the petition.

Specification of Errors.

The errors which petitioners will urge, if the writ of certiorari is granted, are that the Circuit Court of Appeals for the Fourth Circuit erred—

(1) In reversing the decree of the District Court and reinstating the bill of complaint as to the first two patents in suit.

(2) In failing to hold that the two patents are invalid because of the invalid disclaimer filed with respect to each thereof.

(3) In failing to hold the two patents invalid for failure to file an adequate disclaimer of the invalidated claims within a reasonable time after the invalidation thereof, and/or prior to the filing of the bill of complaint, which was more than nine months subsequent to the finality of invalidation.

(4) In failing to affirm the decree of the District Court dismissing the bill of complaint as to the first two patents in suit.

Summary of Argument.

The points of the argument follow the reasons relied upon for the petition for the writ, and, for the sake of brevity, are not repeated at this point.

ARGUMENT.

1. The decision of the Court of Appeals for the Fourth Circuit in this case, in holding, in effect, that there was no compulsion upon the patentee to disclaim the previously invalidated claims as a condition precedent to the commencement (more than nine months subsequent thereto) or maintenance of the present suit, is directly opposed to and in direct conflict with the decision of this Court in *Ensten* vs. *Simon Ascher & Co.*, 282 U. S. 455.

In *Ensten* vs. *Simon Ascher & Co., supra,* this Court reviewed the history of Sections 4917 and 4922 of the Revised Statutes and pointed out, quoting from *Hailes* vs. *Albany Stove Co.,* 123 U. S. 582, that before their enactment a patent was wholly void if any part of the invention was wrongfully claimed by the patentee. The Court further pointed out that the statute is remedial, and that escape from complete invalidation of the patent due to subject matter invalidly included therein "is permitted only to one who acted originally in good faith and who has complied with the prescribed conditions" of the statute.

The statute (see Appendix B, pp. 26-27) denies escape to the patentee who has "unreasonably neglected or delayed to enter a disclaimer". In the *Ensten* case this Court said (quoting from Robinson on Patents):

> "Delay begins whenever the patentee becomes aware that he has claimed more than he has invented or described.",

On the question of *when* the patentee becomes aware that he has claimed more than he invented, this Court said:

> "When a competent court has declared his pretensions without sufficient foundation, we think good faith and the spirit of the enactment demand that he act with such promptness as the circumstances permit either to vindicate his position or to relieve the public from further evil effects of his false assertion."

With the foregoing brief consideration of the decision of this Court in the *Ensten* case it at once becomes apparent that the decision of the Court of Appeals for the Fourth Circuit in the case at bar is directly opposed thereto and in direct conflict therewith. In the present case the Court of Appeals for the Third Circuit invalidated claim 9 of one patent and claims 3 and 14 of the other patent (59 Fed. (2) 305, 309). This Court denied writs of certiorari on October 25, 1932. The bill of complaint in the present case was not filed until more than nine months thereafter.

Plaintiffs' contention (which was adopted by the Court of Appeals) is the bald one that because the unreasonably delayed disclaimer in fact disclaimed nothing, it should be ignored, and the claims treated as though no disclaimer had been filed; and *that no patentee is compelled to take advantage of the disclaimer statute;* and that a patentee, with claims finally adjudged to be invalid by a Court of competent jurisdiction, may, if he desires to do so, elect not to avail himself of the benefits of the disclaimer statute, and thereby be in the position to sue anyone, other than the defendant in the previous litigation, in any other Circuit at any time throughout the life of the patent. In other words, plaintiffs' contention is that a patentee who does not file an effective disclaimer of previously invalidated claims, may at any time, during the life of the patent, secure an adjudication, *de novo* on the validity of the claims of his patent in another jurisdiction.

This contention, which was accepted by the Court of Appeals for the Fourth Circuit and becomes the law in that Circuit by the decision in the present case, is, we submit, wholly opposed to the intent and purpose of Sections 4917

and 4922 R. S., and to the decision of this Court in the *Ensten* case.

In the later case of *Altoona Publix Theatres* vs. *American Tri-Ergon Corp.*, 294 U. S. 477, this Court noted at page 491 (citing numerous authority to that effect) that the settled rule is that unreasonable delay in making a disclaimer invalidates the whole patent. In the present case there is no question as to the delay being *unreasonably* long because the patentees say, in effect, that not only have they failed to file an effective disclaimer to meet the invalidation of their claims by the Court of Appeals for the Third Circuit, but that they have no intention of ever doing so. On the contrary, they assert a right to try out the question of validity of their claims in every judicial circuit of the Union when and as they please.

A patent monopoly, as this Court has often said, is a creature of stature. It is in derogation of the public interest, and each time that it is sought to enforce the monopoly the validity thereof must be carefully scrutinized. Thus, a patentee, seeking to enforce the monopoly established by his grant, subjects his grant to the test of an adjudication of the validity thereof. Each time that it is endeavored to enforce the monopoly thereafter, subject only to the principles of *res adjudicata*, comity, and *stare decisis*, public interest demands that the validity be again carefully scrutinized. On the other hand, if on the initial attempt to enforce the monopoly it is finally found to be invalid by a Court of competent jurisdiction, there is no rule or reason which should or does permit the invalid monopoly to be attempted to be enforced, in whole or in part, in any other jurisdiction.

The Court of Appeals in the present case, as justification for its decision, cites several cases in which, after the invalidation of one or more claims in one Circuit, the same claims have been adjudged valid in another Circuit. It should be noted, however, that in all such instances the decisions were rendered long prior to the decision of this Court in the *Ensten* case, and that in none of them was the dis-

claimed statute or its effect called to the attention of the Court or considered by it.

The result of the decision of the Court of Appeals for the Fourth Circuit, unless corrected by this Court in a review of the present case, is that, although one or more claims of a patent are held to be invalid by a Court of last resort in one Circuit, the patentee may, at any time during the life of the patent, if he has not filed a disclaimer of the invalid claims, sue other infringers on the same and/or other claims of the patent (if there be any) in any other Circuit of the Federal Judicial System.

This result is in such sharp conflict with the decision of this Court in the *Ensten* case that the present petition should be granted and the decision of the Court of Appeals for the Fourth Circuit overruled.

2. The decision of the Court of Appeals for the Fourth Circuit in this case holding, in effect, that the inadequate and invalid disclaimer filed by the patentee more than eight months after the previous adjudication of invalidity by the Court of Appeals of another Circuit, can be ignored and a trial on the merits had as though no disclaimer had been filed, is directly opposed to and in direct conflict with the decision of this Court in *Altoona Publix Theatres* vs. *American Tri-Ergon*, 294 U. S. 477.

The disclaimer, which was filed by plaintiffs with respect to both of the patents in suit eight months and thirteen days after denial of writs of certiorari, admittedly "disclaimed nothing". The Court of Appeals said in its opinion (Vol. 1, p. 424):

> "We may assume, for the purposes of the pending case, that in effect no disclaimer has been filed as to the claims passed on in the Third Circuit, for even if the delay of 8 months is satisfactorily accounted for,

> the plaintiff admits, as the defendants contend and the District Judge held, that the so-called disclaimers disclaimed nothing and amounted only to an admission that the broad language of the claims should be limited to the disclosures of the specifications, in accordance with the well established rule."

Thus, the patentee in the present case has filed an invalid disclaimer, which automatically and irrevocably invalidates the original claims, as this Court expressly held in *Altoona Publix Theatres* vs. *American Tri-Ergon Corp.*, 294 U. S. 477. This Court said (at p. 491):

> "With the invalid disclaimer must fall the original claims as they stood before the disclaimer. The disclaimer is a representation, as open as the patent itself, on which the public is entitled to rely, that the original claim is one which the patentee does not, in the language of the statute 'choose to claim or hold by virtue of the patent'. Upon the filing of the disclaimers, the original claims were withdrawn from the protection of the patent laws and the public was entitled to manufacture and use the device originally claimed as freely as though it had been abandoned. To permit the abandoned claim to be revived, with the presumption of validity because the patentee had made an improper use of the disclaimer, would be an inadmissible abuse of the patent law to the detriment of the public."

It will be noted that in the present case claims 9, 11 and 12 of patent No. 1,635,117 are involved, and that the invalid disclaimer was filed with respect to each thereof. Similarly, claims 1 to 4, 13 and 14 of patent No. 1,455,141 are involved in the suit, and the invalid disclaimer was filed with respect to each thereof.

It thus appears that the decision of the Court of Appeals for the Fourth Circuit in the present case, which treats the claims in their original form as though no disclaimer had been filed with respect thereto, is directly opposed to and in direct conflict with the decision of this Court in the *Altoona Publix Theatres* vs. *American Tri-Ergon Corp.* case, *supra*, and should be reversed by this Court.

3. The rule established by the decision of the Court of Appeals for the Fourth Circuit in this case in construing the disclaimer sections of the statute (Sections 4917 and 4922 R. S.) as to the necessity for filing disclaimers and the time within which they must be filed, is in direct conflict with the rule established by the Court of Appeals for the Second Circuit.

The Courts in the Second Circuit have passed squarely upon the identical issue presented in the present case, and have reached a conclusion diametrically opposed thereto. In *Hoe* vs. *Goss Printing Press Co.*, 31 Fed. (2) 565, the Second Circuit Court of Appeals, rejecting the identical contentions made by the plaintiffs in the court below, and established as the law in the Fourth Circuit by the decision of the Court of Appeals in the present case, said, in a *per curiam* opinion,

> "The plaintiff at bar goes further, however, arguing that, even after denial of an application for certiorari, the patentee should not be obliged to disclaim. It argues that the Circuit Court of Appeals of another circuit might disagree with our ruling, and the Supreme Court would then take the case on certiorari and might declare the claims valid. A disclaimer would merely destroy this right, though the defendant is protected forever by its decree, and really has no interest in the disclaimer at all. While we acknowledge the difficulty and the possibility, it appears to us that so to extend the patentee's time might result in avoiding the statute altogether. The patentee may not sue again, or, if he does, the result may be the same. It does not follow, because two Circuit Courts of Appeals have held the same way, that a third will not disagree. Must the patentee disclaim at the conclusion of the second suit, or may he wait until all nine circuits have passed upon his claims? The question is at best of seasonable action, and in practice there must be some end, short of exhausing all conceivable remedies. When the patent has once passed

> through all the courts then available, the statute should have its effect; else the putatively invalid claims may remain as scarecrows, preserved against the bare possibility that at some future time they may come to life."

See also, *Better Packages Inc.* vs. *Nashua Package Sealing Co., Inc., et al,* 6 Fed. Supp. 573 S. D. N. Y., affirmed 74 Fed. (2) 682, certiorari denied 55 S. C. 830; *Radio Condenser Co.* vs. *General Instrument Corp.,* 65 Fed. (2) 458.

Moreover, the patentees delayed for more than eight months after finality of invalidation in filing the invalid disclaimer. This delay alone invalidates the patents in their entirety under the decision of this Court in the *Ensten* case, and the "30 day rule" established in the Second Circuit in the cases above cited.

The precise question—what period of time constitutes undue delay—is involved in the petition for a writ of certiorari, which, it is understood, has been or will be filed in behalf of the defendant in *Standard Wholesale Phosphate and Acid Works Inc.* vs. *The General Chemical Company,* seeking a review of the decision of the same Court of Appeals for the Fourth Circuit. In that case (77 Fed. (2) 230) the Court of Appeals reversed the District Court of Maryland which had dismissed the bill of complaint because of a delay in excess of thirty days (adopting the Second Circuit rule), and excused a delay materially in excess thereof.

Thus it is evident that there is direct, complete and irreconcilable conflict between the Second and Fourth Circuit Courts of Appeals which should be settled by this Court in a review of the present case.

4. The decision of the Circuit Court of Appeals for the Fourth Circuit in this case to the effect that the present suit was properly brought or can be maintained notwithstanding the prior adjudication of invalidity of some of the claims of the patents, and the failure to file a disclaimer of their invalid subject matter, is directly opposed to the express provisions of Section 4922 R. S.

Treating the claims, as did the Court of Appeals for the Fourth Circuit in the present case, as though no disclaimer has been filed as to the claims previously invalidated by the Court of Appeals for the Third Circuit, then it is apparent, from the express wording of the statute, that, in the absence of such a disclaimer, filed without "unreasonable neglect or delay" after the invalidation, the present suit could not be maintained.

Section 4922 R. S. (35 U. S. C. 71) expressly provides that

> "Whenever, * * * a patentee has * * * claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee * * * *may maintain* a suit at law or in equity, for the infringement of *any part thereof which was bona fide his own* * * * notwithstanding the specification may embrace more than that of which the patentee was the first inventor or discoverer. * * * *But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.*" (Italics ours.)

From this it will be seen that the statute expressly provides that a suit for infringement may be maintained on a patent with invalidated claims therein—

(1) *only* on claims which have *not* been invalidated; and

(2) *only* if the patentee has *not* "unreasonably neglected or delayed to enter a disclaimer."

Obviously, if a suit may not be *maintained* except on those conditions, no suit can be properly *instituted* except on those conditions. In the present case, however, *neither* of those conditions are met. Plaintiffs have sued, and the Court of Appeals has decided they have the right to maintain a suit, not only on claims of the patent not previously adjudicated, but on the previously invalidated claims as well. Likewise, with respect to the second of the above conditions, not only has the patentee in the present case completely neglected and delayed to file disclaimers of the invalid subject matter of the two patents in suit, but has avowed an intention not to do so, and repudiates any obligation on his part to file such disclaimers as a condition precedent to maintaining a suit for infringement in a jurisdiction other than that in which the invalidation was decreed.

It follows, therefore, that the decision of the Court of Appeals for the Fourth Circuit is directly contrary to the statute, and establishes a rule for that Circuit, and a precedent in patent cases, in such direct conflict with the statute as to require review of the present case by this Court and the reversal thereof.

5. This case involves important questions of law arising under the patent statutes which should be settled by this Court.

While, as hereinbefore pointed out, the decisions of this Court in *Ensten* vs. *Simon Ascher, supra,* and *Altoona Publix Theatres* vs. *American Tri-Ergon, supra* and the language of Section 4922 R. S. clearly indicate that the decision of the Court of Appeals for the Fourth Circuit in the present case

is erroneous, apparently this Court has never passed squarely on the question of whether or not a disclaimer of invalid subject matter is *compulsory* upon a patentee, subsequent to a final decree by a Court of competent jurisdiction, as a condition precedent to the commencement or maintenance of a suit on other claims of that patent in a jurisdiction other than that in which the invalidating decree was obtained; or on the question of whether or not a patentee may ever sue or maintain a suit in another jurisdiction on claims which have been finally adjudicated to be invalid by a Court of competent jurisdiction. The Courts of Appeals for the Second and Fourth Circuits have answered both of these questions in a diametrically opposite manner.

It is highly important that these questions be determinatively settled by the opinion of this Court so that the rule may be definitely and correctly established in all of the Circuits.

Plaintiff's disingenuous argument, and the decision of the Court of Appeals for the Fourth Circuit in the present case, in practical effect set aside and nullify the provisions of the statute and the recent decisions of this Court with reference thereto.

The questions presented by this case, therefore, should be determined by this Court.

CONCLUSION.

It is earnestly urged that the petition be granted.

Respectfully submitted,

SAMUEL E. DARBY, JR.,
Counsel for Petitioners.

COOK & MARKELL,
Attorneys for Petitioners.

Dated: New York, N. Y.
August 20, 1935.

APPENDIX A.

Disclaimer.

1,635,117.—*Francis W. Dunmore,* Washington, D. C. SIGNAL-RECEIVING SYSTEM. Patent dated July 5, 1927. Disclaimer filed July 8, 1933, by the patentee and the exclusive licensee, *Dubilier Condenser Corporation.*

Hereby enter their disclaimer to:

(1) Any "source of alternating current power supply" in claim 1 except such as delivers rectified alternating current to said grid electrodes and raw alternating current to said filament electrodes; to any "means associated with said alternating current power supply for impressing a negative potential on said grid electrodes" in said claim 1, except such means as comprise a resistance in series with said grid electrodes shunted by a condenser; to any "means for energizing said filaments" as specified in claims 2, 3, 4, 5, and 6, except such means as supply raw alternating current to said filaments; and to any "rectifier adapted to supply a negative potential to said grid electrodes" as specified in claims 2, 4, 5, and 6 except such as supply such negative grid biasing potential by means of a bias determining resistance in series with the grid electrodes and connected to the respective cathodes of the amplifying tubes and shunted by a condenser of low impedance to power supply frequencies.

(2) Any "filament electrodes" specified in claim 9 except such as are energized by raw alternating current; and any "means for supplying a negative potential to the grid electrode of said electron tube from said source of alternating current" as specified in claim 9 except such means as comprise a bias determining resistance connected in a series path between the grid and filament electrodes and shunted by a condenser of low impedance to power supply frequencies.

(3) Any "source of power adapted to be energized by alternating current or the like" as specified in claim 11, except such as supplies raw alternating current to the cathode heating circuits of such tubes and rectified current to the grid circuits of such tubes; and to any "output terminals connected at opposite terminals of said resistance" as specified in said claim, except such as are also connected to the grid and cathode of the vacuum tube.

(4) Any "method of energizing thermionic vacuum tubes or the like from a source of alternating current" as specified in claim 12, except such as supplies raw alternating current to the cathode heating circuit of such tubes and rectified current to the grid circuit of such tubes; and to "impressing the desired portion of such voltage drop upon said thermionic tube" except to impressing the desired portion of the voltage drop upon the grid-cathode circuit of said thermionic tube.

[*Official Gazette August 1, 1933.*]

Disclaimer.

1,455,141.—*Percival D. Lowell* and *Francis W. Dunmore*, Washington, D. C. RADIO RECEIVING APPARATUS. Patent dated May 15, 1923. Disclaimer filed July 8, 1933, by the patentees and the exclusive licensee, *Dubilier Condenser Corporation.*

Therefore enter their disclaimer as follows:

(1) To any "source of alternating current for supplying power to said amplifying means" as set forth in claim 1 except such as supplies raw alternating current to the cathode heating circuit or circuits of such amplifying means and rectified current to the plate circuit or circuits of such amplifying means; to any "plurality of means in circuit with said amplifying means for eliminating the hum of said alternating current in said apparatus" except such means as comprises:

(*a*) a connection from the grid to the amplifying means to the cathode thereof at a point not subjected to the influence of variations of the cathode heating current; (*b*) elements connected between the stages of said amplifying means which prevent the passage of power supply frequencies; and (*c*) a resistor shunted by a condenser interposed in the circuit between the grid and cathode of the amplifying means where said condenser forms a low impedance path for both signal and power supply frequencies and wherein the voltage drop across said resistor provides a negative bias for the grid of the amplifying means.

(2) To any "source of alternating current for supplying power to said amplifying means "as set forth in claim 2 except such as supplies raw alternating current to the cathode heating circuit or circuits and rectified current to the plate circuit or circuits; to any "means connected to said amplifying and rectifying means for eliminating the hum of said alternating current in said apparatus" except as comprises: (*a*) a connection from the grid of the amplifying means to the cathode thereof at a point not subjected to the influence of variations of cathode heating current; (*b*) elements connected between the stages of said amplifying means and between said amplifying and rectifying means which prevent the passage of power supply frequencies; and (*c*) a resistor shunted by a condenser interposed between the grid and the cathode of the amplifying means, where said condenser forms a low impedance path for both signal and power supply frequencies and wherein the voltage drop across said resistor provides a negative bias for the grid of the amplifying means.

(3) To any "source of alternating current for supplying power to said amplifying means" as set forth in claim 3 except such as supplies raw alternating current to the cathode heating circuit or circuits and rectified current to the plate circuit or circuits of such amplifying means; to any "sepa-

rate means connected to each of said amplifying and rectifying means for eliminating the hum of said alternating current" except as comprises: (*a*) connecting the grid of the amplifying means to the cathode thereof at a point not subjected to the influence of variations of the cathode heating current, and (*b*) elements connected between the "means for amplifying said signal energy at radio frequencies" and the "means for rectifying said energy" which prevent the passage of power supply frequencies.

(4) To any "source of alternating current for supplying power to said amplifying means" as set forth in claim 4 except such as supplies raw alternating current to the cathode heating circuit or circuits of such amplifying means and rectified current to the plate circuit or circuits of such amplifying means; to any "means connected to each of said amplifying, rectifying, and reproducing means for eliminating the hum of the alternating current" except such as comprises: (*a*) connecting the grid of the amplifying means to the cathode thereof at a point not subjected to the influence of variations of the cathode heating current, and (*b*) elements connected between stages of the amplifying means and between the amplifying means and the rectifying means which prevent the passage of power supply frequencies.

(7) To any "means in different parts of said circuits for eliminating the hum of the alternating current" as set forth in claim 7 except such as comprises: (*a*) connecting the grids of said amplifying means to the cathodes thereof at a point not subjected to the influence of variations of the cathode heating current; (*b*) elements interconnecting the stages of the "means for amplifying said energy at radio frequencies" and elements interconnecting the "means for amplifying said energy at radio frequencies" with the "means for rectifying said energy" which prevent the passage of alternating current hum; and (*c*) such means as a resistor shunted by a condenser connected in a circuit between the grid and cathode of

the "means for amplifying said energy at radio frequencies" where the said condenser forms a low impedance path for both signal and power supply frequencies.

(13) To any "means for supplying the rectified energy to circuits of said vacuum tube amplifiers" as set forth in claim 13, except such as supplies such rectified energy to the plate circuits of said vacuum tube amplifiers and also supplies raw alternating current to the cathode heating circuit or circuits of said amplifiers; to any "means connected in each of the circuits of said amplifiers, detector and reproducer for eliminating the hum of said alternating current" except such as comprises: (*a*) connecting the grids of the amplifiers to the cathodes thereof at a point not subjected to the influence of variations of the cathode heating current; (*b*) elements interconnecting the stages of said radio frequency vacuum tube amplifier and interconnecting the output of said radio frequency vacuum tube amplifier with the detector which prevent the passage of power supply frequencies; and (*c*) a resistor shunted by a condenser and connected in the circuit between the grid and cathode of each of said amplifiers, where the said condenser forms a low impedance path for both signal and power supply frequencies.

(14) To any "means in each of said circuits for eliminating the hum" as set forth in claim 14, except as comprises: (*a*) connecting the grids of vacuum tubes to the cathodes thereof at a point not subjected to the influence of variations of the cathode heating current, and (*b*) interconnecting the plurality of vacuum tubes which amplify the signal at radio frequencies through elements which prevent the passage of power supply frequencies.

(15) To any "vacuum tubes" as set forth in claim 15 except vacuum tubes which have the grid electrodes thereof connected with the cathodes thereof at a point not subjected to

the influence of variations of the cathode heating current; and to any "circuits interconnecting said electrodes and said detector" as specified in said claim except such circuits as include an inductively coupled radio frequency transformer.

(16) To any "source of alternating current for supplying power to said amplifying means" as set forth in claim 16 except such as supplies raw alternating current to the cathode heating circuit or circuits and rectified current to the plate circuit or circuits; to any "means connected in circuit with said rectifying means for smoothing out the rectified current and supplying power to said amplifying means" except such as also prevents distortion of the signal current.

(18) To any "source of alternating current for supplying power to said circuits" as set forth in claim 18 except such as supplies raw alternating current to the cathode heating circuit and rectified current to the plate circuit or circuits of the vacuum tubes; to any "means connected in circuit with said grid and plate electrodes for eliminating the hum" except as comprises: (*a*) connecting the grids of the vacuum tubes to the cathode thereof at a point not subjected to the influence of variations of the cathode heating current, and (*b*) interposing filter elements in the plate circuit to reduce fluctuation in power supply frequencies; and to any "circuits interconnecting said electrodes" except as include a radio frequency transformer.

(19) To any "source of alternating current" as set forth in claim 19 except as supplies raw alternating current to the cathode heating circuit or circuits of said vacuum tubes; and to any "circuits interconnecting said electrodes" except as include elements which prevent the passage of power supply frequencies.

(20) To any "source of alternating current for supplying power to said amplifying means" as set forth in claim 20

except as supplies raw alternating current to the cathode heating circuit or circuits of said amplifying means and rectified current to the plate circuit or circuits of said amplifying means.

(21) To any "source of alternating current for supplying power to said tubes" as set forth in claim 21 except as supplies raw alternating current to the cathode heating circuit or circuits and rectified current to the plate circuit or circuits of said tubes.

[*Official Gazette August 1, 1933.*]

APPENDIX B.

SEC. 4917. Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

SEC. 4922. Whenever, through inadvertence, accident, or mistake, and without any willful default, or intent to defraud

or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.